

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 22-32 and 37 are rejected under 35 U.S.C. 102(b) over the patent to Okamoto.

Claims 33, 36 and 38-42 are rejected under 35 U.S.C. 103(a) over the patent to Okamoto in view of the patent to Haas.

Also, the claims are objected to.

After carefully considering the Examiner's grounds for the rejection of the claims, applicant has canceled the original claims and submitted new claims 43-57.

It is respectfully submitted that the new features of the present invention which are now defined in the claims clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

In accordance with the present invention, it is defined in claim 43 that the throughhole is recessed by stamping, erosion or laser beam boring, and the recessing of the outlet region 75 is performed by a non-metal-cutting production process.

It is known that none of the references teaches these new features of the present invention. The recessing of the throughhole by stamping, erosion or laser beam boring as well as of the downstream outlet region 75 from an injection end of the throughhole with a non-metal-cutting production process is not disclosed in the patent to Okamoto and the reference does not contain any hint or suggestion for such features. The reference does not disclose any processing steps, so that for the processing method for the outlet region only classic material-removing methods can be used in this reference.

The patent to Haas does not teach the new features of the present invention as defined in claim 43, in particular the specific combination for manufacture of the outlet openings on valves as defined in this claim.

The original claims were rejected as anticipated by the patent to Okamoto or as obvious from the combinations of the patent to Okamoto and the patent to Haas. As for the anticipation rejection, it is believed to be advisable to cite the decision in Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references do not contain every element of the present invention which is defined in claim 43. Therefore, the anticipation rejection should be considered as no longer tenable and should be withdrawn.

Also, the references do not contain any hint or suggestion for the features of claim 43. In order to arrive at the applicant's invention from the combination of the references, the references have to be fundamentally modified by including into them the features which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

The references do not have any hint or suggestion for such modifications. Therefore, it is believed that the rejection based on the obviousness over the two references should also be considered as not tenable and should also be withdrawn.

Claim 43 should be considered as patentably distinguishing over the art and should be allowed.

Claims 44-50 define the new features of the present invention, which in combination with the features of claim 43, also are not disclosed in the references and can not be derived from them as a matter of obviousness.

Claim 51 substantially corresponds to claim 43, and in addition defines that in a first method step a blind bore is created from an inlet side

and opposite to an injection end, while in a second method step from the injection end of the outlet opening, an outlet region up to the blind bore is created, to produce a continuous outlet opening. The new features of the claim 51 are also not disclosed in the references and can not be derived from them as a matter of obviousness for the same reasons, and therefore claim 51 should be considered as patentable over the art and should be allowed.

The same is true with respect to claims 52-57 which defines specific method steps in combination with the features of claim 51. These claims should be considered as being in allowable condition as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233